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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,150	01/04/2002	Jeffrey Allen Sturgill	UVD 0299 PA	7448

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EXAMINER	
KASTLER, SCOTT R	
ART UNIT	**PAPER NUMBER**
1742	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,150	STURGILL ET AL.	
	Examiner	Art Unit	
	Scott Kastler	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-53 and 123-125* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-53 and 123-125* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-53 and 123-125 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-48 of copending Application No. 10/038,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because the corrosion inhibiting conversion coating of the '274 application is substantially identical in composition as the seal of the instant claims, and the instantly recited seal can be solid in form, as recited in claim 1 of the '274 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant is advised that should claims 11 and 32 be found allowable, claims 124 and 125 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-10, 12-31, 33, 35-43 and 123 are rejected under 35 U.S.C. 102(b) as being anticipated by Schapira et al. Schapira et al teaches the claimed composition comprising a combined cobalt and cobalt valence stabilizer, as recited in claim 1, including stabilizers that are claimed as a member of the claimed lists of claims 6, 8, 9 and 12-29, including the solubility adjuster substituent claimed in the lists of claims 30, 31 and 33, including the solubility control agent of claims 35-40, and the additional additives of claims 41-43 (see the abstract and col. 2-col. 6 for example). With respect to specific properties recited in the dependent claims, including solubility, the electrostatic barrier, the ion exchange property, and the cavity containing cobalt and an additional ion are inherent properties necessarily present from the presence of the same claimed chemicals, namely the trivalent cobalt complex that has been combined with a ligand (a valence stabilizer).

Claims 1, 3-10, 12-31, 33, 35-43 and 123 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of the instant disclosure. The admitted prior art of the instant

disclosure, at pages 9 and 10 for example, teaches compositions for seals which meet the requirements of the instant claims, including both a trivalent cobalt compound and a valence stabilizer compound. See particularly, applicant's citation of Japanese patents 77 06,258, 76 42,057, 74 34,929 and 74 14,621 for example.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schapira et al in view of Ouyang et al. As applied to claim 1 above, Schapiara et al shows all aspects of the above claims except to expressly teach the instantly claimed coloring or coloring additives for the coatings. Ouyang et al teaches that it was known in the art at the time the invention was made to employ colorings and coloring additives in coatings of the type taught by Schapiara et al in order to provide the coatings with desirable color properties. Motivation to include the colorings and coloring additives of Ouyang et al in the compositions taught by Schapiara et al would have been a modification obvious to one of ordinary skill in the art at the time the invention was made because Schapiara et al would also desire the improved coloring properties provided by the coloring and coloring additives taught by Ouyang et al.

Response to Arguments

Applicant's arguments filed on 5/17/2005 have been fully considered but they are not persuasive. Applicant's argument that the obviousness type double patenting rejections have been overcome because the compositions of the instant claims and those of the '124 application are employed in a different manner is not persuasive. As stated in the above rejection, the actual compositions claimed are substantially identical and their use as a seal on various surfaces which commonly employ such seals would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's further argument that neither Schapira or the admitted prior art of the instant disclosure teach seals with cobalt formed within the seal itself is not persuasive because, since the compositions of the applied references and the instant claims are substantially identical as are the application methods, then one of ordinary skill in the art would reasonably conclude that the trivalent or tetravalent cobalt complexes of either of Schapira or the admitted prior art of the instant disclosure would also be present in the coatings in substantially the same concentrations as that of the instant claims. With respect to applicant's arguments regarding the properties, specifically the central cavity of instant claim 10, as stated in the above rejection, the Examiner has provided a rationally for a finding of inherency, namely "With respect to specific properties recited in the dependent claims, including solubility, the electrostatic barrier, the ion exchange property, and the cavity containing cobalt and an additional ion are inherent properties necessarily present from the presence of the same claimed chemicals, namely the trivalent cobalt complex that has been combined with a ligand (a valence stabilizer).".

Applicant's further argument that the teachings of the Japanese patents of the admitted prior art of the instant disclosure are purely speculative and therefore not an actual teaching is not persuasive. A reference is applicable for all that it fairly teaches, including non-preferred embodiments. In the instant case, the Japanese patents still properly disclose the subject matter of the instant claims as applied above, even if the disclosure is in the form of a specualative or possible embodiment rather than a preferred embodiment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Kastler
Primary Examiner
Art Unit 1742

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